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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/010,603

11/08/2001

Peter Morrison

3089

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27727

7590

06/18/2004

PEDERSEN & COMPANY, PLLC

P.O. BOX 2666

BOISE, ID 83701

EXAMINER

ARYANPOUR, MITRA

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,603

Applicant(s)

MORRISON, PETER

Examiner

Mitra Aryanpour

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the language repeats information given in the title. Therefore the "title" appearing on the top of the page should be deleted. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7 and 17 do not further limit claims 5 and 15 respectively. Despite a slight difference in wording the content of claims 7 and 17 cover the same thing as in claims 5 and 15 respectively.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9 and 11-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Young (GB 2,332,630A).

Regarding claim 1, Young discloses a training apparatus for soccer players comprising a number of substantially rigid targets (3) arranged around an area (see figure 1) for the player.

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NOTE: The recitation of the intended use of the claimed invention, in the instant case “the targets (3) being positioned and adapted such that a ball struck by the player against a target (3) will rebound into the training area so that the player can immediately strike the ball at the same or another target” must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, Young shows the targets (3) are separated (see figure 12; page 12, lines 13-20), in which retaining means (hinge members 41 connect the adjacent panels 40 together) and is located between adjacent targets (see figure 13).

Regarding claim 3, Young shows each target (3) is mounted upon a substantially rigid frame member (2).

Regarding claim 4, Young shows the target (3) is releasably mounted (see column 1, lines 40-43) to the frame member (2).

Regarding claims 5-7, Young further shows the targets (3) are arranged upon a circular base member (the broadest reasonable interpretation of circular would include frame 2; best seen in figures 2 and 12) and they are movable with respect to the base member (frame 2; the targets 3 are releasably attached or detached for ease of transportation).

Regarding claims 8 and 9, Young further shows the targets (3) carry identifying indicia (the indicia on the targets replica the indicia on a soccer ball; see page 9, lines 4-12) providing

instructions regarding the targets (3) to be aimed at (the targets illuminate which give a visual message to the trainee or alternatively the targets are provided with a sound module which generate an audible tone whenever a ball pad has been successfully struck; the apparatus is provided with various programs that is controlled by the trainee 32 through a control unit 33; see pages 13 through 15).

Regarding claim 11, Young further shows the targets (3) are substantially vertical (see figures 10 and 11).

Regarding claims 12-18 and 20, note the rejection of claims 1-9, 11. During normal use and operation of the Young device, the method steps set forth by applicant in the claim is inherently provided.

Additionally:

6. Claims 1, 3, 4, 8, 10-12, 14, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (5,527,185).

Regarding claim 1, Davis discloses a training apparatus for training a player in a spherical ball sport such as soccer, basketball or field hockey (see figures 1, 6, 9 or 10) comprising a number of substantially rigid targets (1, 17, 18 or 19) arranged around an area (see column 9, lines 37-49, wherein Davis teaches that a plurality of targets may be arranged in various positions on the playing field) for the player, the targets (1, 17, 18 or 19) are positioned such that a ball struck by the player against a target (1, 17, 18 or 19) will rebound into the training area (the playing field), which allows the player to strike the ball at the same or another target. NOTE: The recitation of the intended use of the claimed invention, in the instant case “the targets (3) being positioned and adapted such that a ball struck by the player against a target (3)

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will rebound into the training area so that the player can immediately strike the ball at the same or another target” must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 3, Davis shows each target (1, 17, 18 or 19) is mounted upon a substantially rigid frame member (combination of upright 6 and base 5).

Regarding claim 4, Davis shows the target (1, 17, 18 or 19) is releasably mounted (see column 8, lines 5-22; also column 10, lines 9-16) to the frame member (combination of upright 6 and base 5).

Regarding claim 8, David further shows the targets (1, 17, 18 or 19) carry identifying indicia (they have uniforms corresponding to the particular sport).

Regarding claim 10, Davis shows each target (1, 17, 18 or 19) is in the form of a mannequin (see figures 6-10).

Regarding claim 11, Davis further shows the targets (1, 17, 18 or 19) are substantially vertical (again see figures 6-10).

Regarding claims 12, 14, 19 and 20, note the rejection of claims 1, 3, 8 10 and 11. During normal use and operation of the Davis device, the method steps set forth by applicant in the claim is inherently provided.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (5,527,185).

Regarding claims 5-7, Davis further shows the targets (1, 17, 18 or 19) are arranged upon a base member (5) and they are movable with respect to the base member (the targets are releasably and telescopically attached; see figures 5 and 7). Davis teaches that the targets can be positioned in any arrangement in order to optimally cover the playing field and the offensive players. Therefore, it would have been obvious to also arrange the targets in a circular ring if such was deemed necessary in order to optimally cover the playing field.

Response to Arguments

9. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
10 June 2004



MITRA ARYANPOUR
PATENT EXAMINER